REMARKS

Claims 14-17 are cancelled without prejudice herein. Accordingly, claims 1-13 remain pending in the application. Claims 1, 2, 3, 7, 8 and 9 have been amended herein, with the amendments supported by the application as originally filed.

The present Office Action reiterates the restriction requirement under 35 U.S.C. § 121 to one of the following inventions and requests affirmation of the provisional election made with traverse via telephone on July 18, 2005:

I. Claims 1-13, drawn to an apparatus, and classified in class 425, subclass 72.2; and

II. Claims 14-17, drawn to a method, classified in class 264, subclass 103.

The present Office Action also provisionally rejects claims 1-13 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-6, 9-11 and 13-15 of copending Application No. 10/650,540 (as US2005/0046090 A1); rejects claims 1-3 and 7-10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,679,379 issued to Fabbricante et al. in view of U.S. Patent No. 4,586,690 issued to Hartel et al.; rejects claims 4-6 and 10-13 under 35 U.S.C. § 103(a) as being unpatentable over Fabbricante et al. in view of Hartel et al. and further in view of U.S. Patent No. 3,613,170 issued to Soda et al.

The undersigned affirms the provisional election made with traverse, via telephone call on July 18, 2005, to prosecute the invention of Group I, i.e., the

apparatus, claims 1-13. Claims 14-17 are cancelled without prejudice herein, as being drawn to a non-elected invention.

Applicant acknowledges the provisional rejection of claims 1-13 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-6, 9-11 and 13-15 of copending Application Serial No. 10/650,540. In response, Applicant is filing a Terminal Disclaimer concerning copending and commonly assigned U.S. Patent Application Serial No. 10/650,540 concurrently herewith. Accordingly, reconsideration and withdrawal of Examiner's provisional rejection of claims 1-13, under the judicially created doctrine of obviousness-type double patenting, over claims 1-3, 5-6, 9-11 and 13-15 of copending and commonly assigned Application Serial No. 10/650,540, is respectfully requested.

The rejections of claims 1-3 and 7-10 under 35 U.S.C. § 103(a) as being unpatentable over Fabbricante et al. in view of Hartel et al., are respectfully traversed. It is respectfully submitted that the proposed combination of Fabbricante et al. and Hartel et al. does not teach or suggest the features and functions of claims 1-3 and 7-10 for at least the following reasons. In the first instance, it is respectfully submitted that Fabbricante et al. and Hartel et al. are improperly combined. Fabbricante et al. is directed to an extrusion apparatus assembled from modular die units (col. 1, ll. 8-10). Fabbricante et al. explains that the then-existing prior art extrusion dies were typically made from a block of steel in which various channels and die tips were machined or drilled and that, as extrusion dies grew larger and more complicated because of the use of multiple thermoplastic melts and drawing fluids, the complexity of machining

increased geometrically as well as the costs for manufacturing the die (col. 1, ll. 19-34). Fabbricante et al. further indicates that an additional factor that adds to the costs of using extrusion dies is a requirement that they be frequently cleaned, which requires that additional dies be available for spares, and that dies have a limited life because of the erosion of the die tip tolerances due to the high temperature and the wear of the fluids flowing through the dies under high pressures (col. 1, ll. 30-39). Fabbricante et al. further indicates that accordingly, it is an object of the invention disclosed in Fabbricante et al. to provide a modular extrusion die apparatus where specially shaped plates are confined (intent believed to be "combined" based on quoted passage below) in a repeating series to create a sequence of easily and economically manufactured modular die units which are contained in a die housing (col. 1, ll. 46-52). Fabbricante et al. further indicates the following:

> "The essence of the invention is the formation of modular die units using specially shaped plates which are combined in a repeating series to create a die which can be manufactured in any length and width required without complicated and expensive machining requirements." (col. 2, ll. 12-17)

The modular die plate assembly disclosed in Fabbricante et al. is formed by the alternate juxtaposition of primary die plate of first embodiment 4 and secondary die plate of first embodiment 3 in a continuing sequence (col. 4, ll. 61-64).

Fabbricante et al. indicates that the die housing may contain heating elements and temperature sensing elements, and that the heating elements may be contained within the modular plates (col. 1, ll. 63-67). However, Fabbricante et al. does not illustrate or further discuss heating elements.

Applicant agrees with the following statement by Examiner in the present Office Action:

> "Fabbricante et al. fail to teach the side faces confronting each other and having a heating element passage and heating element therebetween due to recesses on plates abutting one another." (Office Action, pg. 6)

However, it is respectfully submitted that Examiner's proposed combination of Hartel et al. with Fabbricante et al. to teach heating element passages and heating elements is improper. Hartel et al. discloses two heating plates 18 and 20 which are firmly connected and have slots formed in the contact surfaces thereof which face each other (col. 3, ll. 51-53). Hartel et al. further indicates that slots 22a, 22b are formed in the contact plane of the upper heating plate 18 which is closest to or facing the molding tool 12 and slots 24a, 24b formed in the contact surface of the lower heating plate 20 (col. 3, ll. 54-58). Hartel et al. further discloses tubular heating elements 26a, 26b, 27a 27b having the shape of approximately rectangular loops which are disposed concentrically to each other (col. 3, ll. 64-68; Figs. 1 and 2). The outer slots 22a, 22b and the corresponding tubular heating elements 26a, 26b are located in the contact surface of the upper heating plate 18 facing or closest to the molding tool 12, while the inner slots 24a, 24b and the associated tubular heating elements 27a, 27b are located in the contact surface of the lower heating plate 20 since in this area, the radiation losses are smaller and therefore the use of a small distance between the heat source and the molding tool 12 is not necessary (col. 3, l. 68 to col. 4, l. 11). Hartel et al. does not teach or suggest heating elements that appear in a continuing sequence in the disclosed heating device. Instead, heating elements 26a and 26b are disposed in plate

18 while heating elements 27a and 27b are disposed in plate 20, with the device also including plates 28, 30 and 32. None of the other plates include heating elements.

It is respectfully submitted that modifying the Fabbricante et al. device with two plates and the included heating elements of Hartel et al., such as plates 18 and 20 and the included heating elements, is not consistent with the function of the Fabbricante et al. device, and in fact the stated "essence of the invention" to provide modular die units using specially shaped plates which are combined in a repeating series to create a die. It is respectfully submitted that a 103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed and the reference (here the intent, purpose or function of Fabbricante et al.) is not proper and a prima facie case of obviousness cannot be properly made (see In re: *Gordon*, 733 F.2d 900, Fed. Cir. 1984).

Assuming *arguendo* that Fabbricante et al. and Hartel et al. are properly combined, it is respectfully submitted that the proposed combination of documents do not teach or suggest the structural features and functions of claims 1-3 and 7-10 for at least the following reasons. Independent claims 1 and 7 each recited the following in part as filed: "at least two of said side faces confronting each other and having a heating element passage therebetween, a heating element positioned within said heating element passage for heating at least two of said plates,". Independent claims 1 and 7 have both been amended to further recite "said heating element passage being formed by respective first and second aligned recesses on different ones of said plates which abut one another,". In contrast, as illustrated in Figs. 1 and 2 of Hartel et al.,

Hartel et al. discloses slots 22a and 22b formed in plate 18 which accept heating elements 26a and 26b and further discloses slots 24a and 24b formed in plate 20 which accepts heating elements 27a and 27b. Slots 22a and 22b are not aligned with slots 24a and 24b as clearly shown in Fig. 1. The heating elements 26a, 26b, 27a and 27b of Hartel et al. are disposed in separate plates, but are not disposed in aligned passages formed in two abutting plates.

In view of the foregoing, it is respectfully submitted that the proposed combination of documents does not teach or suggest the features and functions of independent claims 1 and 7 or of claims 2 and 3 which depend from claim 1 and claims 8-10 which depend from claim 7. Claims 2 and 3 have been amended to be consistent with amended claim 1 and claims 8 and 9 have been amended to be consistent with amended claim 7.

In view of the foregoing, it is respectfully submitted that Examiner has not established a prima facie case of obviousness with respect to claims 1-3 and 7-10 and accordingly, Examiner's reconsideration and withdrawal of Examiner's rejections of claims 1-3 and 7-10 under 35 U.S.C. § 103(a) as being unpatentable over Fabbricante et al. in view of Hartel et al., is respectfully requested.

The rejections of claims 4-6 and 10-13 under 35 U.S.C. § 103(a) as being unpatentable over Fabbricante et al. in view of Hartel et al. and further in view of Soda et al. are respectfully traversed. Claims 4-6 each depend, either directly or indirectly from pending independent claim 1 and claims 10-13 each depend, either directly or indirectly, from pending independent claim 7. Accordingly, it is respectfully submitted

that claims 4-6 and 10-13 patentably distinguish over the proposed combination of documents for at least the reasons set forth previously with respect to the discussion of the rejection of claims 1 and 7 over Fabbricante et al. in view of Hartel et al. In view of the foregoing, reconsideration and withdrawal of Examiner's rejections of claims 4-6 and 10-13 under 35 U.S.C. § 103(a) as being unpatentable over Fabbricante et al. in view of Hartel et al. in further view of Soda et al., is respectfully requested.

Conclusion

In view of the foregoing response including the amendments and remarks, this application is submitted to be in complete condition for allowance and early notice to this affect is earnestly solicited. If the Examiner believes any matter requires further discussion, the Examiner is respectfully invited to telephone the undersigned attorney so that the matter may be promptly resolved.

Applicant does not believe that any fees are due in connection with this response other than the disclaimer fee. The Commissioner is authorized to charge the disclaimer fee to Deposit Account No. 23-3000. If any other fees are necessary, the Commissioner is hereby authorized to charge any necessary fees to deposit account 23-3000.

Respectfully submitted,
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